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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,585	12/29/2000	Eric T. Lambert	YOR920000560US1/I27-0005	8383

7590 05/05/2005  
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EXAMINER

RUDY, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 05/05/2005

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**MAILED**

**MAY 05 2005**

**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/751,585  
Filing Date: December 29, 2000  
Appellant(s): LAMBERT ET AL.

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Marisa J. Dubue  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 10, 2005.

**(1)    *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2)    *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3)    *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4)    *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(87) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Prior Art of Record**

5109337	Ferriter et al.	4-1992
5765138	Aycock et al.	6-1998
6493685	Ensel et al.	12-2002
6813777	Weinberger et al.	11-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 40-71 are rejected under 35 U.S.C. (a). This rejection is set forth in a prior Office Action, mailed on March 30, 2004. With regards to Official Notice, Weinberger is enclosed to support the Official Notice taken.

**(10) Response to Argument**

Applicant's Appeal Brief is noted. Upon review of Appellant's Brief the following is added. It is noted that Appellant's method claims does not use or manipulate any of the list of databases claimed. In short, the method for facilitating part qualification functions does not require the list of databases. Great Atlantic & Pacific Tea Co. V. Supermarket Equipment Corp., 1950, 340 US 147, 71 S.Ct. 127, 95 L.Ed. 162. "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention." Lincoln Engineering Co. V. Stewart Warner Corp., 1938, 303 US 545, 549, 58 S.Ct. 662, 664, 82 L.Ed. 1008. "As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. To be entitled to such weight in method claims, the

recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here." *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961).



The Official Notice traversal is acknowledged. Weinberger, US 6,813,77, is added as it discloses each of the various databases claimed by Appellant. It is the Examiner's position that each of these databases have been common knowledge in the art, as evidenced by Weinberger.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Andrew Joseph Rudy  
May 2, 2005

Conferees  
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